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WORDPRESS FOUNDATION

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

WORDPRESS FOUNDATION,

Plaintiff,

v.

EDWARD JEFFREY YABLON and  
PC-VIP, INC.,

Defendants.

Case No.:

**COMPLAINT FOR:**

- (1) **INFRINGEMENT OF FEDERALLY REGISTERED TRADEMARK**  
[SECTION 32 OF THE LANHAM ACT, 15 U.S.C. § 1114];
- (2) **FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION**  
[SECTION 43(A) OF THE LANHAM ACT, 15 U.S.C. § 1125(A)];
- (3) **ANTICYBERSQUATTING CONSUMER PROTECTION ACT** [15 U.S.C. § 1125(D)];
- (4) **TRADEMARK INFRINGEMENT**  
[CAL. BUS. & PROF. CODE § 14245];
- (5) **UNFAIR COMPETITION**  
[CALIFORNIA BUSINESS AND PROFESSIONS CODE § 17200 *ET SEQ.*]

**[DEMAND FOR JURY TRIAL]**

1 The Plaintiff, WordPress Foundation ("WPF"), for its Complaint against the Defendants,  
2 Edward Jeffrey Yablon ("Yablon") and PC-VIP, Inc. (PC-VIP) herein alleges:

### 3 JURISDICTION AND VENUE

4 1. This action arises under the trademark and unfair competition laws of the United States,  
5 the Anticybersquatting Consumer Protection Act, and California State law.

6 2. This action is brought pursuant to 15 U.S.C. § 1114, § 1125(a), and § 1125(d), and the  
7 California Business and Professions Code § 14245 and § 17200 *et seq.*

8 3. This Court has jurisdiction over the subject matter of this case pursuant to 15 U.S.C. §  
9 1121, 28 U.S.C. § 1331, § 1338(a), and § 1338(b), and supplemental jurisdiction pursuant to 28 U.S.C.  
10 § 1367.

11 4. Plaintiff is informed and believes, and on that basis alleges, that this Court has personal  
12 jurisdiction over the Defendants because the Defendants are, and have been, conducting continuous  
13 and systematic business by promoting and selling services within the State of California and within the  
14 boundaries of the Northern District of California. Defendants have also caused harm and committed  
15 unlawful acts hereinafter complained of in this judicial district, and Plaintiff has suffered harm in this  
16 judicial district as a result of Defendants' conduct.

17 5. Venue is appropriate in this district in accordance with 28 U.S.C. § 1391(b) and (c).

### 18 PARTIES

19 6. WPF is a corporation organized under the laws of the State of California, having an  
20 office and principal place of business at 200 Brannan Street #511, San Francisco, California, 94107.

21 7. Defendant Yablon is an individual residing in New York, New York, where he is doing  
22 business as The WordPress Helpers and has identified himself as the President of the same. His listed  
23 address is 115 East 87<sup>th</sup> Street, New York, New York.

24 8. Defendant PC-VIP is a New Jersey corporation with its principal place of business at  
25 333 Alpine Court, Stanhope, New Jersey. Upon information and belief, Defendant PC-VIP is the parent  
26 company of The WordPress Helpers. Defendant Yablon has also identified himself as the President and  
27 Chief Executive Officer of Defendant PC-VIP.

28 \\\





## ALLEGATIONS COMMON TO ALL COUNTS

### The Business of WordPress Foundation

9. The WordPress Foundation, in part through its predecessor in interest and licensees (collectively, "WPF") uses the WordPress Trademarks, as defined in paragraph 17 *infra*, in connection with the well-known WordPress blogging software, and related services in interstate commerce since as early as 2003. WordPress is the largest self-hosted blogging tool and online publishing platform in the world, used on millions of sites and seen by tens of millions of people every day. The goods and services offered and sold by WPF are well-known and highly desirable to consumers.

10. Over the past thirteen years, WPF has marketed, sold, and provided its goods and services under the WORDPRESS trademark, a stylized version of the WORDPRESS word mark

 WORDPRESS, and a unique, stylized "W" logo .

11. WPF considers its intellectual property amongst its most valuable assets and acts to protect it accordingly.

12. WPF has owned federal trademark registrations for the WORDPRESS trademark and WORDPRESS & Design stylized trademark in the United States since January 23, 2007, for:

Downloadable software program for use in design and managing content on a website and Software solutions, namely providing use of on-line non-downloadable software for use in enabling internet publishing

(U.S. Registration Nos. 3201424 and 3201428), claiming a date of first use in commerce as March 28, 2003. In February of 2012, WPF timely complied with the requirements of 15 U.S.C. § 1065, and as such, has achieved the incontestable right to use the WORDPRESS trademark and WORDPRESS & Design stylized trademark in the United States. Copies of the registrations for the U.S. Registration Nos. 3201424 and 3201428 are attached hereto as Exhibit A.

13. WPF is also the owner of the "W" logo, which has been registered in the United States since July 5, 2011, for:

computer software for use in design and managing content on a website and enabling internet publishing and electronic publishing

1 services, namely, publication of video, text and graphic works of  
2 others via the Internet  
3 and since April 9, 2013, for

4 Clothing, namely, t-shirts, sweatshirts, jackets, pullovers, tank tops  
5 and shorts and Application service provider (ASP), namely,  
6 providing use of on-line non-downloadable software for use in  
7 design and managing content on a website and enabling internet  
8 publishing,

9 (U.S. Registration Nos. 3988241 and 4317426), claiming dates of first use in commerce as March 28,  
10 2003, for the software goods and services and July 2006 for the apparel. Copies of the registrations for  
11 U.S. Registration Nos. 3988241 and 4317426 are attached hereto as Exhibit B.

12 14. WPF is also the owner of two pending U.S. Trademark applications for the  
13 WORDPRESS trademark, both filed November 7, 2014, for:

14 electronic publishing services, namely, publication of video, text  
15 and graphic works of others via the Internet and clothing, namely,  
16 t-shirts, hats, sweatshirts, jackets, pullovers, tank tops and shorts.

17 (U.S. Application Serial Nos. 86448439 and 86448426), claiming a date of first use in commerce as  
18 March 28, 2003. Copies of the Trademark Status and Document Retrieval Records for U.S. Application  
19 Serial Nos. 86448439 and 86448426 are attached hereto as Exhibit C.

20 15. WPF has filed for or obtained registration of the various WordPress trademarks  
21 discussed in paragraph 10 for use in connection with these goods and services in more than 60  
22 countries around the world. Information regarding the status of these applications and registrations is  
23 attached hereto as Exhibit D.

24 16. In addition, WPF provides numerous services related to those identified in its trademark  
25 applications and registrations identified above, including but not limited to education, information, and  
26 training services, all for the purpose of supporting users of WPF's core services.

27 17. The pending applications and registrations in paragraphs 12-15, and the additional uses  
28 described in paragraph 16 will be collectively referred to as the "WordPress Trademarks."

18 18. WPF has used the WordPress Trademarks in interstate commerce throughout the United  
19 States to identify and distinguish its goods and services from the products and services provided by



1 other entities since at least as early as 2003, and has expended significant resources promoting and  
2 advertising the WordPress Trademarks in connection with these goods and services.

3 19. As a result of the significant sales, promotion, and use of the WordPress Trademarks,  
4 WPF's trademarks have become widely recognized by the general consuming public of the United  
5 States as a designation of source of the goods and services of WPF. WPF has expended and continues  
6 to expend resources promoting and advertising the WordPress brand and the goods and services  
7 provided thereunder. As a result of such promotion and advertising, coupled with the reputation of the  
8 high quality and popularity of WPF's goods and services, the WordPress Trademarks have attained  
9 goodwill among consumers nationally and around the world. The WordPress Trademarks and the  
10 goodwill of the business associated therewith are of inestimable value to WPF.

11 20. WPF has also spent significant time and resources preventing the unauthorized use of  
12 the WordPress Trademarks by third parties. WPF actively monitors the U.S. Federal Trademark  
13 Registry and diligently acts to protect the WordPress Trademarks.

14 21. WPF has a written and publicly available policy that governs the use of the WordPress  
15 Trademarks by others, including the use and registration of the WordPress Trademarks in domain  
16 names.

### 17 **Defendant's Business and Infringement**

18 22. Defendant Yablon is an individual based in New York, doing business as The WordPress  
19 Helpers, and has designated himself the President of the same. Defendant PC-VIP is a New Jersey  
20 Corporation, and the parent company of The WordPress Helpers.

21 23. Defendants offer and provide commercial services in the field of website design,  
22 training, and other services utilizing WPF's platform ("Infringing Services").

23 24. The Infringing Services are available to the public via Defendants' website at  
24 [www.thewordpresshelpers.com](http://www.thewordpresshelpers.com) and are further marketed by Defendants through social media online  
25 platforms, such as Facebook and Twitter. In connection with the provision of the Infringing Services,  
26 Defendants' website displays multiple third party advertisements tailored to each visitor of the website.

27 25. Defendants have registered and currently own multiple domain names incorporating the  
28 WordPress Trademarks, including but not necessarily limited to: thewordpresshelpdesk.com,

1 thewordpresstrainers.com, thewordpressteachers.com, thewordpressdoctors.com, wordpresstraffic.com,  
2 and thewordpresstutors.com (collectively, the "Infringing Domain Names"), and are using the  
3 Infringing Domain Names to direct consumers to The WordPress Helpers website.

4 26. WPF learned of Defendants' unauthorized use of the WordPress Trademarks and  
5 registration of the Infringing Domain Names in January of 2015. Since that time, WPF has repeatedly  
6 reached out to the Defendants requesting that they cease use of the WordPress Trademarks and transfer  
7 the Infringing Domain Names to WPF.

8 27. Defendants have refused to comply with WPF's requests, and on May 12, 2015,  
9 Defendant Yablon instituted an opposition proceeding with the Trademark Trial and Appeal Board  
10 (TTAB), opposing registration of WPF's U.S. Trademark Application Serial No. 86448439 for the  
11 WORDPRESS trademark in connection with:

12 electronic publishing services, namely, publication of video, text  
13 and graphic works of others via the Internet.

14 28. Defendants market, promote, provide, and sell the Infringing Services through the same  
15 channels of trade and to the same customers as WPF, using the WordPress Trademarks. Attached as  
16 Exhibit E are representative screenshots of Defendants' webpage advertising and providing the  
17 Infringing Services. Consumers may be confused as to the source of Defendants' Infringing Services,  
18 the affiliation between Defendants and WPF, or the sponsorship of Defendants' services by WPF due to  
19 the use of the WordPress Trademarks.

20 29. The Infringing Services are identical in some respects, and highly related in other  
21 respects, to WPF's services in that both sets of services include electronic publishing services; design  
22 and website management and solutions; and education, information, and training services, all provided  
23 in connection with the WordPress platform.

24 30. Defendants' use of the WordPress Trademarks in connection with the Infringing  
25 Services falsely creates the impression that the Infringing Services are sponsored by or affiliated with  
26 WPF and constitutes trademark infringement and unfair competition.

27 31. Defendants do not have the consent of WPF to use the WordPress Trademarks.  
28



32. The Infringing Services are not WPF's services, and Defendants do not have the sponsorship, consent, approval, or certification of WPF to use the WordPress Trademarks in connection with the Infringing Services.

33. Defendants' unfair competition and infringement demonstrate intentional, willful, and bad faith attempts to deceive or to create mistake or confusion in the minds of WPF's customers and potential customers and of the public, to trade on WPF's goodwill, to palm off Defendants' services as those of WPF, and to create the false impression of a connection, affiliation, association, sponsorship, or approval of or between WPF and Defendants, all causing irreparable injury to WPF.

34. WPF has no adequate remedy at law.

35. By reason of Defendants' activities, WPF has suffered actual damages for injury to its goodwill and reputation, and injury to its relationships with customers and potential customers.

36. Because of Defendants' bad faith and intentional and willful infringement, unfair competition, and deceptive trade practices, Plaintiff is entitled to recover punitive damages to deter Defendants from repeating their unlawful activities, as well as Plaintiff's attorneys' fees and the costs of this action.

#### **FIRST CLAIM FOR RELIEF**

#### **INFRINGEMENT OF FEDERALLY REGISTERED TRADEMARK**

#### **(LANHAM ACT: 15 U.S.C. § 1114)**

37. WPF realleges and incorporates by reference the allegations of paragraphs 1 through 36 as if fully set forth in this paragraph.

38. Defendants' promotion, advertising, provision, sale, and offering for sale of the Infringing Services under the WordPress Trademarks is likely to confuse, mislead, or deceive consumers, the public, and the trade as to the origin, source, sponsorship, or affiliation of said products and services, and is intended and is likely to cause such parties to believe in error that the Defendants' Infringing Services have been authorized, sponsored, approved, endorsed, or licensed by WPF, or that Defendants are in some way affiliated with WPF.

39. Defendants' activities, as described herein, constitute infringement of WPF's WordPress Trademarks in violation of the Lanham Act, including, but not limited to, 15 U.S.C. § 1114.

40. Defendants' use of the WordPress Trademarks with the Infringing Services has been and continues to be willful, deliberate, unfair, false, deceptive, and intended to trade upon the goodwill and reputation appurtenant to the WordPress Trademarks.

41. Defendants' acts have damaged and will continue to damage WPF, and WPF has no adequate remedy at law.

42. WPF is entitled to injunctive relief prohibiting Defendants from using the WordPress Trademarks, or any marks confusingly similar thereto, in accordance with 15 U.S.C. § 1116, and to recover all damages, including attorneys' fees, that Plaintiff has sustained and will sustain, and all gains, profits, and advantages obtained by Defendants as a result of their infringing acts alleged above in an amount not yet known, as well as the costs of this action, pursuant to 15 U.S.C. § 1117(a).

## **SECOND CLAIM FOR RELIEF**

### **FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION**

#### **(LANHAM ACT: 15 U.S.C. § 1125 (A))**

43. WPF realleges and incorporates by reference the allegations of paragraphs 1 through 42 as if fully set forth in this paragraph.

44. Defendants' conduct complained of herein constitutes federal unfair competition, false designation of origin, and false advertising pursuant to 15 U.S.C. § 1125(a).

45. Defendants' intentional, unlawful, and unauthorized use in commerce of the WordPress Trademarks, and Defendants' false advertising in commerce as described herein, is likely to cause confusion, mistake, or deception as to origin, sponsorship, or approval of Defendants' services and therefore constitutes false designation of origin and false advertising, in violation of 15 U.S.C. § 1125(a). Defendants' acts have damaged and will continue to damage WPF, and WPF has no adequate remedy at law.

46. WPF is entitled to injunctive relief prohibiting Defendants from using the WordPress Trademarks, or any marks confusingly similar thereto, in accordance with 15 U.S.C. § 1116, and to recover all damages, including attorneys' fees, that WPF has sustained and will sustain, and all gains, profits, and advantages obtained by Defendants as a result of the infringing acts alleged above in an amount not yet known, as well as the costs of this action, pursuant to 15 U.S.C. § 1117(a).



1 **THIRD CLAIM FOR RELIEF**

2 **ANTICYBERSQUATTING CONSUMER PROTECTION ACT**

3 **(LANHAM ACT: 15 U.S.C. § 1125 (D))**

4 47. WPF realleges and incorporates by reference the allegations of paragraphs 1 through 46  
5 as if fully set forth in this paragraph.

6 48. Upon information and belief, Defendants have and continue to have a bad faith intent to  
7 profit from the registration and continued use of the Infringing Domain Names by creating an  
8 association with WPF's distinctive WORDPRESS trademark.

9 49. Defendants have registered, trafficked in, and used the Infringing Domain Names,  
10 which incorporate the identical WordPress Trademarks.

11 50. The WordPress Trademarks were distinctive at the time of Defendants' registration and  
12 the Infringing Domain Names wholly contain the WordPress Trademarks.

13 51. WPF has been damaged by Defendants' unlawful use and registration of the Infringing  
14 Domain Names and will suffer irreparable harm.

15 52. Defendants' acts, as aforesaid, are in violation of the Anticybersquatting Consumer  
16 Protection Act under Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d).

17 53. As a result of Defendants' actions, WPF is entitled to immediate transfer of any domain  
18 names incorporating the WordPress Trademarks, including the Infringing Domain Names, in  
19 accordance with 15 U.S.C. § 1125(D)(1)(c); and an award of statutory damages of between \$1,000 and  
20 \$100,000 per each of the Infringing Domain Names pursuant to 15 U.S.C. § 1117(d).

21 **FOURTH CLAIM FOR RELIEF**

22 **TRADEMARK INFRINGEMENT**

23 **(CALIFORNIA BUSINESS & PROFESSIONS CODE § 14245)**

24 54. WPF realleges and incorporates by reference the allegations of paragraphs 1 through 53  
25 as if fully set forth in this paragraph.

26 55. WPF is the owner and authorized user of the WordPress Trademarks, with the right to  
27 enforce the WordPress Trademarks. Defendants are not authorized to use any of the WordPress  
28 Trademarks.

56. Defendants' use of the WordPress Trademarks without WPF's permission constitutes unauthorized reproduction, counterfeit, copying, or colorable imitations of the WordPress Trademarks.

57. Without WPF's consent, Defendants have used the WordPress Trademarks in connection with the sale, provision, distribution, offering for sale, and advertising of the Infringing Services in California in a manner likely to cause confusion or mistake, or to deceive as to the source of the Infringing Services. Defendants engaged in the unauthorized use of the WordPress Trademarks with knowledge and intent to create confusion or mistake, or to deceive as to the source of the Infringing Services.

58. Defendants' actions have caused, and unless enjoined will continue to cause, substantial and irreparable injury to WPF for which WPF has no adequate remedy at law, including but not limited to substantial and irreparable injury to the goodwill and reputation associated with the WordPress Trademarks.

59. WPF is entitled to injunctive relief, recovery of Defendants' profits, actual damages, treble profits and damages, costs, and reasonable attorneys' fees.

### FIFTH CLAIM FOR RELIEF

## UNFAIR COMPETITION

(CALIFORNIA BUSINESS & PROFESSIONS CODE § 17200 *et seq.*)

60. WPF realleges and incorporates by reference the allegations of paragraphs 1 through 59 as if fully set forth in this paragraph.

61. WPF is informed and believes, and on that ground alleges, that Defendants have intentionally appropriated WPF's trademarks with the intent of causing confusion, mistake, and deception as to the sources of the Infringing Services with the intent to palm off the Infringing Services as those of WPF, and as such, have committed unfair competition in violation of California law.

62. The foregoing acts of the Defendants have caused and will continue to cause injury to WPF by depriving WPF of sales of its genuine goods and services, injuring its business reputation, and by passing off Defendants' goods and services, including the Infringing Services, as WPF's goods and services, all in violation of the law of the State of California.



63. Defendants' acts have caused and will continue to cause irreparable harm and damage to WPF, and have caused and will continue to cause WPF monetary damage in an amount thus far not determined, for which WPF is entitled to its actual damages, Defendants' profits, punitive damages, attorneys' fees, and costs.

64. Defendants' infringement of the WordPress Trademarks constitutes "unlawful, unfair or fraudulent business act[s] or practice[s] and unfair, deceptive, untrue or misleading advertising" within the meaning of California Business and Professions Code § 17200 *et seq.*

65. As a consequence of Defendants' actions, WPF is entitled to injunctive relief and an order that Defendants disgorge all profits on the use, display, or sale of the Infringing Services.

#### **PRAYER FOR RELIEF**

WHEREFORE, the Plaintiff, WPF, requests that this Court:

A. Permanently enjoin and restrain Defendants, their officers, agents, servants, employees, directors, representatives, successors, assigns, related companies, and those in privity with Defendants or in active concert or participation with Defendants from:

(1) using the WordPress Trademarks or any confusingly similar phrases, trademarks, or trade names in connection with the advertising, promotion, provision, and marketing of its services in a way that is likely to cause confusion among consumers, including as incorporated in domain names, social media accounts, and other online platforms;

(2) representing by words or conduct that Defendants or their services are authorized, sponsored, endorsed, or otherwise connected with WPF;

(3) marketing and providing any goods or services that bear the WordPress Trademarks, including but not limited to displaying promotional and marketing materials on outlets such as websites, social media platforms, and other sources available over the Internet; and

(4) any other conduct which causes or is likely to cause confusion, mistake, deception, or misunderstanding as to the source, affiliation, connection, or association of the Infringing Services.

B. Require Defendants to immediately transfer to WPF any domain names incorporating the WordPress Trademarks in accordance with 15 U.S.C. § 1125(d)(1)(c);

C. Require Defendants to dismiss, with prejudice, Opposition No. 91221895 currently pending before the United States Trademark Trial and Appeal Board.

D. Award an accounting for, and enter judgment against Defendants for, all profits received from the sale of its services in connection with the WordPress Trademarks in the United States;

E. Award to WPF its damages suffered as a result of Defendants' misconduct in such sum as the Court shall find to be just as a result of the Defendants' acts complained of herein;

F. Award WPF punitive damages to deter such misconduct by Defendants in the future;

G. Award to WPF an increase in the award of damages up to three times the amount found for deliberate and willful trademark infringement and false designation of origin by Defendants pursuant to 15 U.S.C. § 1117(a);

H. Award to WPF statutory damages of between \$1,000 and \$100,000 per each of the Infringing Domain Names pursuant to 15 U.S.C. § 1117(d);

I. Require Defendants to pay the costs of this action together with WPF's attorneys' fees and disbursements incurred herein;

J. Award to WPF pre-judgment and post-judgment interest;

K. Require Defendants pursuant to 15 U.S.C. § 1118 to destroy all materials, both in print and in electronic format, bearing the WordPress Trademarks;

L. Award to WPF such other and further relief as this Court deems just and equitable.

### **JURY DEMAND**

PLAINTIFF DEMANDS A TRIAL BY JURY ON ALL MATTERS DECIDABLE BY JURY

Dated: June 18, 2015

**BARNES & THORNBURG LLP**

By: \_\_\_\_\_



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